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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,265	08/09/2001	Benjamin Andrew Himmel	AUS920010557US1	4193

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EXAMINER

EHICHIOYA, FRED I

ART UNIT	PAPER NUMBER
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2172

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,265

Applicant(s)

HIMMEL ET AL.

Examiner

Fred I. Ehichioya

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicants' arguments, with respect to claims 1 – 24, filed March 22, 2004 have been fully considered but they are not persuasive for the following reasons.

2. Applicants argue:

(a) Makipaa does not disclose that a user can set a preference in customer profile that specifies which database or databases the electronic receipt is to be sent to from the point of sale." (Page 13, Para 1).

(b) neither Makipaa, Smith nor Ogasawara, either alone or in combination, teaches or suggests that merchants and manufacturers may use the electronic receipts to send product information to customers, the product information comprising at least one of the following: extended warranties; product upgrades; product recalls; product safety updates; identical items available for exchange; and alternative and substitute items available for exchange (Page 16, Para 3).

3. Examiner respectfully disagrees with all of the allegations as argued. Examiner, in his previous office action, pointed out exact locations in the cited prior art.

In response to Applicants' argument (a): Examiner respectfully disagrees with the applicants. Examiner wants to point out that this rejection is 35 USC 103 rejections and that the Applicants are attacking each reference individually.

Makipaa teaches creating customer profile in the customer profile management and teaches electronic receipts (see column 2, lines 14 – 42) and Ogasawara discloses setting the user profile that specifies the database. The wireless telephone is the preference database of the customer to receive the electronic receipt. It is obvious to one of ordinary skills that the combination of Ogasawara and Makipaa clearly suggest that the wireless telephone has a database capable of receiving the electronic receipt. The motivation is that the customer can check the electronic receipt from anywhere at any time.

In response to Applicants' argument (b): As discussed in response to argument (a) Makipaa discloses electronic receipts and Ogasawara discloses that the electronic receipt is originated at the server and sent to the wireless telephone and then stored in the IC Card in column 7, lines 33 – 41 and Ogasawara further discloses that the transmitted receipt includes description of returned items, that is the items for exchange see column 10, lines 50 – 57. This clearly suggests that the electronic receipt sent to the customer includes items available for exchange.

4. In view of the above, the examiner contends that all limitations as recited in the

claims have been addressed in this Office Action. For the above reasons, Examiner believed that rejection of the last Office action was proper.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1 - 7, 9, 10, 13, 15, 16, 17, 19, 21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent 6,394,341 issued to Mikko Makipaa et al (hereinafter "Makipaa") in view of U.S. Patent 6,577,861 issued to Nobuo Ogasawara (hereinafter "Ogasawara").

Regarding claims 1, 15 and 23, Makipaa teaches managing an electronic document within a computer network, the method, computer program product and system comprising:

creating a customer profile for a user (see column 11, lines 32 – 36);

sending the electronic receipt from the point of sale device to the one or more databases specified by the user preference (see column 2, lines 1 – 21).

Makipaa teaches electronic receipt (column 1, lines 58 – 63).

However, Ogasawara teaches setting a user preference in a customer profile, wherein the user preference specifies one or more databases, out of plurality of databases, to which an electronic receipt is to be sent from point of sale devices (see column 10, lines 33 – 57);

creating an electronic receipt containing information about a transaction executed by the user at a point of sale device (see column 7, lines 33 - 41)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Ogasawara with the teaching of Makipaa wherein electronic receipts are generated at the point of sales. The wireless telephone is the preference database of the customer to receive the electronic receipt. The wireless telephone has a database capable of receiving the electronic receipt. The motivation is that the customer can check the electronic receipt from anywhere at any time.

Regarding claims 2, 16 and 24, Makipaa and Ogasawara disclose the claimed subject matter as discussed in claims 1, 15 and 23 respectively.

Ogasawara teaches receiving search parameters from the user, wherein the search parameters specify an electronic receipt within the one or more databases specified by the user preference (see column 6, lines 57 – 67 and column 6, lines 21 – 67);

initiating a receipt search object which retrieves the specified electronic receipt from the one or more databases specified by the user preference, according to the search parameters (see column 6, lines 21 – 67).

downloading a copy of the retrieved electronic receipt to a client machine designated by the customer profile (see column 5, lines 5 – 15 and column 7, lines 33 - 35).

Regarding claims 3 and 17, Makipaa teaches wherein the customer profile comprises at least one of the following: customer name; password; credit card numbers; client machine addresses; tax deduction information; purchase classification; and personal financial manager applications used on a client machine (see column 6, lines 47 – 67).

Regarding claim 4, Makipaa teaches wherein the database containing the electronic receipts is on a credit card company server (see column 2, lines 32 – 42).

Regarding claim 5, Makipaa teaches wherein the database containing the electronic receipts is on a manufacturer server (see column 2, lines 43 – 50).

Regarding claim 6, Makipaa teaches wherein the database containing the electronic receipts is on a merchant cash receipt server (see column 2, lines 51 – 62).

Regarding claim 7, Makipaa teaches wherein the database containing the electronic receipts is on a clearing house server (see column 3, lines 40 – 51).

Regarding claims 9 and 19, Ogasawara teaches wherein the search parameters comprise at least one of the following:

customer name; customer password; item type; brand name; approximate date of purchase; approximate purchase price; method of purchase; credit card number; and tax deduction status (see column 5, lines 5– 15).

Regarding claim 10, Ogasawara teaches wherein merchants and manufacturers may use the electronic receipts to send product information to customers, the product information comprising at least one of the following:

extended warranties; product upgrades; product recalls; product safety updates; identical items available for exchange; and alternative and substitute items available for exchange (see column 10, lines 50 – 57 and column 7, lines 33 - 41).

Regarding claims 13 and 21, Ogasawara teaches initiating the receipt search object to delete an electronic receipt from the database, according to the search parameter (see column 18, lines 30 - 36).

7. Claims 8, 11, 12, 14, 18, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makipaa in view of Ogasawara and further in view of U.S. Patent 6,487,540 issued to Steven B. Smith et al (hereinafter "Smith").

Regarding claims 8 and 18, Makipaa or Ogasawara does not explicitly teach wherein the electronic receipt further comprises at least one of the following: customer name; customer password; item type; brand name; date of purchase; purchase price; method of purchase; credit card number; tax deduction status; and warranty information.

Smith teaches wherein the electronic receipt further comprises at least one of the following:

customer name; customer password; item type; brand name; date of purchase; purchase price; method of purchase; credit card number; tax deduction status; and warranty information (see column 3, lines 20 – 26).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Smith with the teaching of Makipaa and Ogasawara wherein electronic receipts embodiments comprise purchase data. The

motivation is that the purchase data clarifies ambiguities in case of return or exchange of purchased items.

Regarding claims 11 and 20, Smith teaches wherein the electronic receipts are encrypted, preventing the information content of the electronic receipts from being modified (see column 6, lines 19 – 24).

Regarding claim 12, Smith teaches wherein the client machine may be at least one of the following:

personal computer; laptop computer; personal digital assistant; mobile telephone; and palm computer (see column 5, lines 55 – 67).

Regarding claims 14 and 22, Smith teaches initiating the receipt search object to automatically delete an electronic receipt from the database at a predefined time (see column 6, lines 30 – 33).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 703-305-8039. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fred I. Ehichioya
Examiner
Art Unit 2172
April 21, 2004



SHAHID ALAM
PRIMARY EXAMINER